IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit 2451 : PATENT APPLICATION

Examiner Backhean Tiv :

In re application of :

THOMAS LEDERER ET AL. : DEVICE AND METHOD FOR USER-BASED
  PROCESSING OF ELECTRONIC MESSAGE
Serial No. 10/563,489 : COMPRISING FILE ATTACHMENTS

Filed January 3, 2006 :

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REPLY BRIEF

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Applicant hereby submits the following reply to the Examiner's Answer mailed on May 24, 2011.

I. NONE OF THE CITED ART TEACHES A SAVE AS AND LINK COMMAND AS REQUIRED BY CLAIMS 12-17 AND 23-26

Claims 12-17 and 23-26 include a limitation requiring actuation of a save as and link command. At least one file attachment is replaced with at least one link via the actuation of this command and a link to the electronic message that had the saved at least one file attachment is created via the actuation of this command. The link to the electronic message is saved in a memory location when the at least one file attachment is saved via the actuation of the save as and link command.

The Examiner admits that none of the cited art teach or suggest a command that causes the replacement of a file attachment with a link in an electronic message, the saving of the one or more file attachments, and the creation and saving of another link to the electronic message in the same memory location as the at least one file attachment all as a result of actuation of one command. (*See* Examiner's Answer, at 14). In fact, the Examiner admits that the cited art does not "teach the use of a save as and link command." *Id.* at 6. Instead, the Examiner has admittedly used "hindsight reasoning" to establish that none of the cited art has taught the use of saving links or emails as construed by the Examiner in rejecting the claims. *Id.* at 14-15.

A. The Examiner Has Not Combined Known Elements According To Known Methods

To justify his use of hindsight reasoning, the Examiner claims that he has merely combined prior art elements according to known methods. (Examiner's Answer, at 7 and 13-14). To the contrary, a combining of known elements of the prior art as construed by the Examiner would be for a user to separately save a file based on use of one command and subsequently

1

navigating for saving of a link to an email to the same place the file was previously saved in a subsequent command. These are the elements that the Examiner claims are disclosed by the cited art and are relied upon by the Examiner.

There is no saved as and link command disclosed in the cited art. Nor is there any disclosure of any suggestion to provide such functionality from a use of a single command that occurs after an electronic message having an attached is received and opened. The elimination of the steps required by the prior art as construed by the Examiner while still retaining the function provided by these many steps by use of the save as and link command of the claimed invention of claims 12-17 and 23-26 is an indicia of the non-obvious nature of the claims. *See In re Edge,* 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP § 2143.01.

B.   The Examiner Failed To Properly Consider Other Evidence Showing The Nonobviousness Of The Pending Claims

The Examiner also failed to consider the evidence that the claimed invention has been recognized by others in the field as being significantly innovative and deserving of patent protection. For instance, European Patent No. EP 1 642 229 shows that the claimed invention has been recognized in the art as being of significance and deserving of patent protection. This evidence also shows that the pending claims are not obvious. The record indicates the Examiner never considered such evidence in using hindsight reasoning to reject the pending claims.

In contrast to the evidence provided by Applicants, the Examiner has relied on no evidence other than his hindsight reasoning for trying to establish obviousness. This is insufficient for meeting the Examiner's burden of proof. The pending claims 12-17 and 23-26 are allowable.

C.   **The Examiner Improperly Relies On Inherency**

The Examiner argues that Windows XP and Outlook inherently disclose the method of creating a link to an electronic message and saving that link in the same file as a file attachment of the electronic message is saved. The Examiner claims that he doesn't have to show the steps of his construed method taught by Outlook or Windows XP was ever practiced because the fact that it could have been practiced is sufficient for showing a teaching of a step in the claimed method. (Examiner's Answer, at 14). Such hindsight guessing is not sufficient evidence.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); MPEP 2112. At best, the Examiner has merely showed that a certain thing may result, not that it has resulted or was ever practiced. As found by the Federal Circuit in *In re Robertson* and as stated in § 2112 of the MPEP, such evidence is insufficient to establish any actual disclosure for use in reject the pending claims.

II.   **NONE OF THE CITED ART TEACHES A SAVE AS AND LINK COMMAND AS REQUIRED BY CLAIMS 18-22 AND 27-30**

As noted above with reference to claims 12-17 and 23-26, the cited art fails to teach or suggest any user input that requires a file attachment to be saved and linked and also requires units to insert a message link in a selected memory location when that user input is received and a fie attachment is saved in the memory location.

Microsoft Outlook 2002 and XP do not teach or suggest any saving of an attachment and also creating a link to the electronic message that initially has such an attachment when the

attachment is saved. For example, there is no "save as and link" user input, command or functionality provided by Outlook 2002 and XP as noted in paragraphs 24-29 of the specification.

As may be appreciated from the screen shots of Figures 1-13 previously provided by the Examiner and referred to in the Office Action, a user must manually save an email to a desktop, then create a short cut link, then save the short cut link in the file in which an attachment is stored to be able to even save such a short cut in that file location by using Outlook 2002 and XP. There is no saving of an attachment while also creating and saving a link to the electronic message in the same file attachment that occurs when the attachment is saved.

Further, Coppinger et al. do not teach or suggest any message links or other links that refer to an electronic message nor the saving of such links in a file or other location in which an attachment from that electronic message is saved. Coppinger et al. only deals with attachments of electronic messages. There is no teaching or suggestion of a saved as and link command nor the functionality provided by actuation of such a command as required by claims 18-22 and 27-30.

For at least the above reasons, the cited art do not teach or suggest each and every limitation of claims 18-22 and 27-30. Therefore, the cited combination of art cannot render these claims obvious

III.   NONE OF THE CITED ART TEACHES A SAVE AS AND LINK COMMAND AS REQUIRED BY CLAIM 31

The cited art does not teach or suggest any attachment substitution unit configured to replace the file attachment of any received electronic message. As noted above, the cited art does not teach or suggest any message link insertion unit that inserts a message link in a file that also has a file attachment of that message stored therein when user input requires the file

attachment to be saved and linked. In fact, none of the cited art teaches or suggests any device to act on user input that requires both a saving of an attachment and linking to occur as required by claim 31.

CONCLUSION

For at least the above reasons, reversal of the rejection of claims 12-31 and allowance of these claims are respectfully requested.

Respectfully submitted,

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